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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/920,600	08/28/97	GREEN	R 1273-004

IM31/0317

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EXAMINER	
GALLAGHER, J	
ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 03/17/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-32 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☑ Claims 1-32 are subject to restriction or election requirement.

Application Papers

☑ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☑ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☑ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

PTOL-326 (Rev. 10/95) ★ U.S. GPO: 1996-409-290/40029

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-2, 6, drawn to an (aerosol) composition and method of dispensing it, classified in class 252, subclass 305.

II. Claims 27-32, drawn to a bonding method, classified in class 156, subclass 304.2 or 308.6.

2. The inventions are distinct, each from the other because:

Inventions I and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as one in which it functions as a coating or paint material rather than as an adhesive. Further along this line see the Brouillette et al. reference, cited below.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, as shown by the above classification, and since the fields of service are not coextensive restriction for examination purposes as indicated is proper.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. In the interest of expedition, the Examiner has seen fit to both impose the restriction requirement and act on all claims presented viz. Claims 1-32.

6. Applicant should note that the undersigned Examiner examines in the area corresponding to/involving the Group II claims.

7. The disclosure is objected to because of the following informalities: (a) page 1 line 2 - replace the quotation marks around "SWC" with/by parentheses i.e. this term should read "(SWC)"; line 24- change "are" to "is"; line 25- change "do" to "does"; (b) page 3 line 5- what is intended by the term "butyrate" unclear/not understood; line 11 - delete "diethoxyethane"; line 12- correct the spelling of "pyrrolidone"; ~~line 13-0 correct the spelling of "pyrrolidone";~~ line 13- correct the spelling of "alcohol" and delete "and"; (c) page 4 line 7 - delete the (1) underlining beneath "valve"; and (2) term "that it"; (d) page 6 line 16 correct the spelling of "formulations" and delete "either'; and (e) page 7- delete lines 7-8 as being IDENTICAL to lines 16-17 on page 6 and therefore redundant.

Appropriate correction is required.

8. Claims 2,15,21-22 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically (a) claims 2, 15, 22 and 28 line 3 of each- term "butyrate" not understood (see paragraph 7(b), above) and (b) claim 21 line 10 - insert "being" before "disposed".

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-7, 10-16, 18-23 and 25-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Masuzaki et al.

Masuzaki et al. disclose an aerosol adhesive composition composed of an adhesive resin (any to include PVC, elastomers (e.g. ABS), acrylics etc.), a solvent (e.g. MEK, MeOH etc.) and a propellant (e.g. DME etc.), (abstract, col. 1 lines 17-18 and 56-63, col. 2 lines 12-16 and 51-57, col. 3 lines 25-26). Any differences which might possibly/conceivably exist between this environed, claimed invention and the teachings of this reference an held/seen NOT to constitute patentable differences, all of the compositional limitations of these claims being held/see to be satisfied by this reference.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 8-9, 17 and 24 are rejected, and claims 19-20 and 26 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Masuzaki et al. In view of SMRT et al..

SMRT et al. disclose that it is known to incorporate a suspending agent (e.g. silica) in aerosol compositions of the type/similar to those of Masuzaki et al. (Abstract, col. 2 lines 41-52, col. 3 lines 22-48, col. 4 lines 2-5 and 64-67, col. 5 lines 11-30 and N.B. lines 02-25), such that it would have been obvious to one of ordinary skill in this art to incorporate such a conventional ingredient/component with composition of Masuzaki et (a); mere incorporation of a known component involved.

13. Claims 27-29 ad 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of applicants admission as to what constitutes prior art (hereinafter referred to as the prior art admission) or King or Meyers, each in view of Masuzaki et al.

The prior art admission (N.B. page 1 lines 14-27 of applicants specification), King (col. 1 line 45 thru col. 2 line 2) and Meyers (abstract, col. 1 lines 47-49 and 55-68, col. 2 lines 1-5, col. 4 lines 11-16) all disclose and/or establish that it is known to join plastic pipe sections/components utilizing an SWC, such that it would have been obvious to one of ordinary skill in this art to employ the adhesive composition of Masuzaki et al. in any of the three foregoing ~~going~~ following processes, in place of the corresponding, analogous adhesive employed therein; mere substitution of one known adhesive/SWC for another involved.

14. Claim 30 is rejected, and claim 32 is further rejected under 35 U.S.C. 103(a) as being unpatentable over any one of the prior art admission or King or Meyers, each in view of Masuzaki et (a) and SMRT et al, ~~see~~ all of record above.

15. Brouillette et(a) are cited in support of the restriction requirement (see paragraph 1, above) ie. to disclose that aerosol compositions composed of an (e.g. acrylic)resin, a solvent and a propellant (e.g. DME) are indeed known to be employed/find utility as coating and/or paint materials, (abstract, col. 1 lines 51-55 and 64, col. 2 lines 34-62).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J.J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on Mon-Fri from approximately 8:30 A.M. to 5:00 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

JJG
Gallagher/maj
3-17-98
March 12, 1998

JOHN J. GALLAGHER
PRIMARY EXAMINER
ART UNIT 131